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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/796,956

03/10/2004

Arcuri B. Kym

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7590 07/25/2007
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EXAMINER

KATAKAM, SUDHAKAR

ART UNIT

PAPER NUMBER

1621

MAIL DATE

DELIVERY MODE

07/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/796,956	Applicant(s) KYM ET AL.	
	Examiner Sudhakar Katakam	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/20/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The examiner has considered applicant's Information Disclosure Statements of 20th December 2004. Please refer to the signed copies of the PTO-1449 forms attached herewith.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is incomplete because it depends from itself.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Spencer et al** (US 5,977,354).

The instant claims are drawn to a process for recovering 2,4,6-trinitrotoluene (TNT) and cyclo-1,3,5-trimethylene-2,4,6-trinitramine (RDX) from a blend of TNT and RDX, comprises introducing the blend into a first vessel wherein TNT is separated from the RDX by use of a solvent that is effective for dissolving TNT but not RDX, the TNT in solvent is passed to a separation stage wherein the solvent is recovered and recycled; the slurry of RDX and water from the first vessel are a passed to a second vessel where the water is displaced with a desensitizing agent.

Spencer et al teach a method for recovering secondary explosive materials, particularly nitramines, from an explosive composition, containing mixture of TNT and at least one secondary explosive [col. 1, lines 33-44], such as RDX [col. 1, lines 62-65]. The method comprises washing the blend with a solvent for TNT and a non-solvent for secondary explosive. For RDX this non-solvent is toluene. The secondary explosive crystals are then washed and dried [col. 2 and lines 19-28].

The difference between the instant claims and the **Spencer et al** is that the instant process further limited to the desensitizing agent, viz., isopropyl alcohol, whereas the reference is silent on desensitizing agent in their process.

The separation of organic compounds based on their suitable solvents is obvious in the art. The removal of organic solvent by separation zones for displacing the

compound to be extracted into a suitable solvent or water is a routine measure for the skilled artisan, especially when the said compound has a negligible solubility in the said organic solvent.

It is therefore would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to have modified the reference teachings, such as selecting the suitable solvent for the compound, to recover the TNT and RDX from their blend with a reasonable expectation of success. Please note that the use of alternative solvents is common practice in the art.

Some limitations of the dependent claims may not be expressly disclosed in **Spencer et al.** However, these limitations appear to be drawn to tweaking the process conditions, particularly recycling of the solvents and desensitizing agent. Modifying such methodology is a prima facie obvious because an ordinary skill artisan would be motivated to use known purification methods to make the process more efficient or explore economical advantages over the other, since it is within the scope to optimize the conditions through routine experimentation.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

Art Unit: 1621

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of US 6,777,586.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

They generically overlap. The instant claims and the US 6,777,586 are drawn to the recovering the TNT and RDX from their mixtures using solvents and solid-liquid separation zones.

The difference between the instant claims and the claims of US 6,777,586 is that the instant claims starts the process with the blend of TNT and RDX, whereas the US 6,777,586 process comprises recovering the TNT and RDX from explosive components and non-explosive components

It would have been *prima facie* obvious at the time the invention was made to one of ordinary skill in the art to start with the teachings of the US 6,777,586 to make instant applicants' process and to expect the recovery of the TNT and RDX. The

difference, however, does not constitute a patentable distinct, because the claims in the present invention simply fall within the scope of US 6,777,586, since the similar reactants and conditions. Hence the instant claims overlap with the claims of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not been patented yet.

Conclusion

9. No Claim is allowed.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhakar Katakam whose telephone number is 571-272-9929. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

Application/Control Number: 10/796,956

Page 7

Art Unit: 1621

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SK


PETER O'SULLIVAN
PRIMARY EXAMINER
GROUP 1200